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Seth Kellogg

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Eggert Stockfleth	Art Unit:	1655
Serial No.:	10/574,422	Examiner:	Qiuwen Mi
Filed:	November 7, 2006	Customer No.:	21559
		Confirmation No.:	7550
Title:	USE OF A POLYPHENOL FOR THE TREATMENT OF A CANCEROUS OR PRECANCEROUS LESION OF THE SKIN		

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PETITION TO WITHDRAW FINALITY UNDER 37 C.F.R. § 1.181

Applicant requests withdrawal of finality of the Office action issued in connection with the above-referenced case on December 18, 2007.

Under M.P.E.P. § 706.07, "the invention as disclosed and claimed should be thoroughly searched in the first action and the references fully applied; and in reply to this action the applicant should amend with a view to avoiding all the grounds of rejection and objection." This section also states, "Switching... from one set of references to another by the examiner in rejecting successive actions claims of substantially the same subject matter[] will... tend to defeat attaining the goal of reaching a clearly defined issue for an early termination..." Furthermore, the "applicant who is seeking to define his or her invention in claims that will give him or her the patent

protection to which he or she is justly entitled should receive the cooperation of the examiner to that end, and not be prematurely cut off in prosecution of his or her application.” Finally, a “second... action on the merits in any application... should not be made final if it includes a rejection, on prior art not of record, of any claim amended to include limitations which should reasonably have been expected to be claimed” (M.P.E.P. § 706.07(a)).

The facts of the case are as follows. On April 23, 2007, the Office issued a restriction requirement requesting, among other things, the election of a skin lesion. Applicant responded to the restriction requirement on May 23, 2007, electing actinic keratosis as the skin lesion. On July 6, 2007, the Office issued a non-final action rejecting the claims for anticipation by Dou et al. (U.S. Patent Application Publication No. 2002/0151582; herein “Dou”), Evans et al. (U.S. Patent Application Publication No. 2003/0143165), Zhao et al. (*Proceedings of the American Association for Cancer Research* 39: 382, 1998), and Hersh et al. (U.S. Patent No. 6,337,320) and for obviousness over the same references. In reply to the non-final Office action, filed on October 5, 2007, Applicant amended claim 1 as follows:

1. (Currently Amended) A method for treating a pre-cancerous lesion of the skin in a patient, said method comprising administering a pharmaceutically effective amount of a polyphenol to said patient .

The pre-cancerous lesion of amended claim 1 had previously been featured in claim 2. As such, Applicant cancelled claim 2.

Applicant’s amendments and arguments were sufficient to remove all rejections of record in the non-final Office action. The Office, however, issued a final action on December 18, 2007 citing new references. The Office rejected the amended claims for anticipation by Li et al. (*Proceedings of the Society for Experimental Biology and Medicine* 220: 218-224, 1999) and Jia et al. (*Cancer Epidemiology, Biomarkers &*

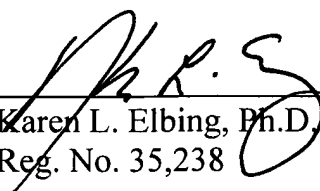
Prevention 11: 1663-1667, 2002) and for obviousness over the same references in view of Brash et al. (U.S. Patent Application Publication No. 2002/0198161), Voet (U.S. Patent No. 6,723,750), and Dou. The Office stated that the new rejections were necessitated by the Applicant's amendment filed on October 5, 2007, but provided no further reason for making the Office action final.

Applicant submits that finality is premature in this case. First, nothing in the amendments to the claims in response to the first Office action changed the scope of the claims in such a way as to make the newly cited references applicable to the currently pending claims, but not to the claims as originally filed. Claim 1 was amended to recite a pre-cancerous lesion, a feature previously recited in pending claim 2 before its cancellation in response to the non-final Office action. Applicant further notes that the species elected in reply to the restriction requirement was actinic keratosis, a pre-cancerous skin lesion (see, e.g., page 3, lines 20-21 of the specification as filed). Without acquiescence to the applicability of the cited references, the pending rejections over the newly cited art could have and should have been made in the previous Office action, violating the tenets of M.P.E.P. § 706.07. Thus, there are no grounds to state that Applicant's amendment necessitated the rejection. Furthermore, under M.P.E.P. § 706.07(a), amendments that are made to recite a feature of a cancelled claim are clearly limitations that should reasonably have been expected to be claimed, and rejection of such claims over new art is improper. Finally, Applicant should not be prematurely cut off from prosecution while seeking the patent protection to which he is justly entitled. In this case, the Examiner has newly rejected in the final Office action a claim over references that could have been applied earlier. Applicant is entitled to an opportunity to present arguments and evidence regarding this rejection and to develop a clear record prior to any appeal. For all of the above reasons, Applicant requests withdrawal of finality.

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03-2095.

Respectfully submitted,

Date: 19 February 2008



Karen L. Elbing, Ph.D.
Reg. No. 35,238

Clark & Elbing LLP
101 Federal Street
Boston, MA 02110
Telephone: 617-428-0200
Facsimile: 617-428-7045